

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

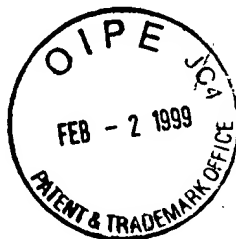
#28/Reply
Brief

In re the Application of:

Chizu SHIMIZU et al.

Serial Number: 08/792,468

Filed: January 31, 1997



RECEIVED

FEB 03 1999

GROUP 2100

Group Art Unit: 2876

Examiner: M. Lee

2-4-99

L. Spruell

For: PURCHASED COMMODITY ACCOMMODATING AND TRANSPORTING
APPARATUS HAVING ELEMENTS FOR PURCHASING A COMMODITY FIXED TO
A TRANSPORTABLE ACCOMMODATION SECTION (AS AMENDED)

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Date: February 6, 1999

Sir:

In response to the Examiner's Answer, the following is the Appellant's Reply Brief.

The Appeal Brief emphasized that the prior art fails to teach or suggest structure for *purchasing* a commodity permanently fixed to a transportable accommodation section. The Examiner implies that Collins, Jr. at col. 3, lines 46+ and Gogulski at col. 5, lines 4+ either teach or suggest this feature. However, while col. 3, lines 46+ of Collins, Jr. teaches that scanning terminal 44 includes a magnetic stripe reader 90 for generating data contained in a credit card which is inserted in the slot 88, it is emphasized that the scanning terminal 44 is not *permanently fixed* to said transportable accommodation section. All apparatus claims (claims 13-26) require either a prepaid card inputting processing section or a magnetic card reading section "permanently fixed to said transportable accommodation section." However, terminal 44 of Collins, Jr. is taught to be

Noted by Examiner
2/16/99

removably mounted to the handle of the grocery cart (see Abstract, for example).

Further, it is emphasized that it would not have been obvious to modify Collins, Jr. to permanently fix scanning terminal 44 to a cart 48. Collins, Jr. does not suggest such a modification, teaching that the scanning terminal 44 is utilized in a check-out operation with the presence of an operator 42 (see col. 2, lines 51-57 and col. 3, lines 35-45 regarding the first embodiment, and col. 4, lines 9-19 regarding the second embodiment).

Further, as discussed in the Appeal Brief, Gogulski fails to suggest an ability to purchase an item with the system attached to the cart, also requiring a check-out system (see Fig. 4, e.g.). Col. 5, lines 4+ of Gogulski (highlighted by the Examiner) fail to suggest any ability to purchase an item with the system attached to the cart.

The Examiner implies on page 4 of the Examiner's Answer that it is unnecessary that the Examiner provide evidence of motivation to modify the references as proposed by the Examiner, citing In re Scheckler ("It is not necessary that the references actually suggest, expressly or in so many words, changes or possible improvements. All that is required is that the invention was made by applying knowledge clearly present in the prior art.") In re Scheckler, 168 USPQ 716, 717 (CCPA 1971). However, this statement merely indicates that suggestions for modifications do not need to be explicitly set forth in writing, i.e., expressed in so many words. This case does not hold that an Examiner may properly reject claims without providing evidence that the prior art teaches or suggests all the recitations of the claims.

There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.

In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

While both Collins, Jr. and Gogulski may suggest various improvements in shopping, neither Collins, Jr. nor Gogulski contemplate that a consumer may purchase the merchandise without an operator at a checkout station; neither suggest permanently fixing either a prepaid card inputting processing section or a magnetic card reading section to a transportable accommodation section. Because the Examiner has failed to provide any evidence in the prior art which suggests the Examiner's proposed modification, it is respectfully asserted that the Examiner has failed to provide a *prima facie* case of unpatentability.

Further, in the Examiner's Answer, the Examiner asserts that because it is well known that "the vendee may choose to either pay for a single item/commodity at a time or to pay for a plurality of items/commodities in a batch mode" the recitations of the methods claims are conventional procedures. However, method claims 27-36 require paying for a commodity at the site of selection of the commodity using a payment processor attached to the transportable container. Paying for one item at a time or a plurality of items at once does not teach or suggest this requirement, nor has the Examiner provided evidence in the prior art which suggests this requirement.

In view of the above, and for the reasons given in the Appeal Brief, it is respectfully requested that the Board reverse the Examiner's rejection.

U.S. Patent Appln. S.N. 08/792,468
By: Chizu SHIMIZU et al.

Attorney Docket No.: 940494B
Page 4

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, WESTERMAN, HATTORI,
McLELAND & NAUGHTON



Patrick D. Muir
Reg. No. 37,403

Atty. Docket No. 940494B
1725 K Street, N.W., Suite 1000
Washington, D.C. 20006
Tel.: 202-659-2930
Fax.: 202-887-0357
PDM/pab